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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,744	12/08/2003	Motoshige Asano	Q78810	9331

7590 11/17/2006  
SUGHRUE MION PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER

LE, THIEN MINH

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,744	<b>Applicant(s)</b> ASANO, MOTOSHIGE	
	<b>Examiner</b> Thien M. Le	<b>Art Unit</b> 2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received. \_\_\_\_\_
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/2003</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

The information disclosure statement filed on 12/8/2003 has been considered.  
The foreign priority document filed on 12/8/2003 has been entered. Claims 1-5 are presented for examination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Landolt et al. (Landolt et al. – 2001/0054642; herein after referred to as Landolt).

Regarding claims 1 and 5, Landolt discloses a printing paper roll for use on a printer comprising: (i) paper roll 7 (figure 3) having a bar code 9 (figure 2); (ii) a bar code reader 3 (figure 3); a rotor core 8 having a passive element 30 for storing identification code and characteristics of paper. The following quotes are herein provide for further reviews (also see the detail descriptions of the related figures):

The beginning of a web material fed to a processing device and stored in the form of a roll on a core is provided with a machine readable code which represents an identification code for the web material as well as property data relevant for the processing of the web material. The identification code and the property data are read in at the beginning of the processing of the web material and only web materials with valid identification code are admitted for processing. The processing device is adjusted to the web material used by way of the read in property data. At termination of the processing, the identification code and the updated property data of the web material are again recorded in machine readable code onto the beginning of the remaining web material so that they are again available for the next processing procedure. Alternatively, the identification code and the property data can also be stored in a storage element activatable by electromagnetic waves which is mechanically connected with the web material. In this manner, the use of unintended web material types can be stopped. The manual entry of property data can be obviated and a higher user-friendliness achieved. Furthermore, incorrect manipulations are substantially prevented. (abstract)

[0016] The processing device in accordance with the invention includes an actual processing unit 1, a control unit 2 for the control and operation thereof, a reader arrangement 3 which is constructed as a barcode reader, a recording arrangement 4 which is constructed as a barcode printer and an administration arrangement 5. Furthermore, a cassette 6 is provided which includes a roll 7 of a web of material P to be processed and wound onto a core 8, which web is fed for processing to the processing unit 1 by way of transport means (not illustrated). With the exception of the presence of the reader arrangement 3, the recording arrangement 4 and the administration arrangement 5, the processing device completely and fully corresponds to the prior art so that further explanation of the remaining components is not necessary.

[0033] A passive storage element without inherent power supply is especially suited as carrier for the identification code and the property data, which element is accessed by electromagnetic waves. Such a storage element consists essentially of an integrated circuit with emitter/receiver functions and a data storage and in general a coil type antenna through which on the one hand the required operating energy is provided and on the other hand data are received and emitted. Suitable passive storage elements and the associated apparatus (transponder) for communication with the storage elements are generally known and sold by the company Texas Instruments, Dallas, Texas, USA, under the trade name TAG-IT.TM.. In the embodiment of FIG. 3, such a passive element 30 is fastened to the core 8 of all permissible paper rolls 7 and includes in its data storage the identification code and the property data of the paper P.

Regarding claim 2, Landolt discloses the method of validating the identification code to ensure the roll of paper is permissible (see the discussions regarding claim 1) that would embrace all limitations set forth in this claim.

Regarding claims 3-4, see the discussions regarding claims 1-2.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Le, Thien Minh', with a stylized, cursive script.

**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**October 31, 2006**